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J.D.

10-22-03

Docket No.: 041-1987

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Satoshi BAN et al.

Serial No. 09/003,812

Filed: 01/07/1998

For: MULTIPURPOSE EARPHONE SET

:
: **EXPEDITED PROCEDURE**
: **Response under 37 CFR 1.116**

:
: Group Art Unit: 2644

:
: Examiner: GRIER, LAURA A.

REQUEST FOR RECONSIDERATION AND CORRECTED ACTION

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COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

The following Request for Corrected Action is submitted in response to the Action mailed April 17, 2003.

As noted during telephone conferences with, and voice mail messages left for, Examiner Grier, Examiner Harvey and Supervisory Examiner Isen on August 29, September 16, September 17 and September 24, 2003, the Official Action mailed April 17, 2003, is believed defective for several reasons. Accordingly, **reconsideration** of the rejection set forth therein, and issuance of a **Corrected Action**, are requested.

As noted by Examiner Harvey on September 24, 2003, Examiner Grier is requested to reply to the present paper expeditiously, in sufficient time to permit applicants an opportunity to determine an appropriate course of action before expiration of the statutory period for reply, which ends October 17, 2003.

As suggested by Examiner Harvey on September 24, 2003, the errors in the Action on which the present requests are based are set forth below.

1. The Pending Rejection Fails to Address the Amended Claim Language

As noted during the various conferences and telephone messages set forth above, in response to an Action mailed November 5, 2003, applicants amended rejected claim 8 in an amendment filed January 8, 2003.

In the presently outstanding Action mailed April 17, 2003, the Examiner again rejected claim 8, as amended.

However, the rejection of amended claim 8 set forth at pages 2-3 of the outstanding Action repeats, verbatim, down to typographical errors, the prior rejection.

Therefore, *the Action fails to address the amendatory language added to claim 8.*

More specifically, the rejection of claim 8 as set forth in the Action fails to address the manner in which the applied art teaches automatically disconnecting an audio signal from an electroacoustical transducer, where the audio signal is provided to the electroacoustical transducer by a first plug, as provided by the amendment.

As such, the outstanding Action provides a rejection of a version of claim 8 which existed prior to addition of the recitation provided by amendment, and fails to provide a rejection of amended claim 8 as actually pending before the Examiner.

Therefore, it is not at all apparent, much less clear, that the pending claim as amended has been considered in formulating the rejection and, therefore, an appropriate response to the Action cannot be formulated. Accordingly, a corrected Action, properly addressing the amended claim, is in order.

2. The Examiner's "Response to Arguments" Fails to Address the Amended Claim

It is noted that the Response provided at page 4 of the Action merely addresses disconnection of an audio circuit (not "signal" as recited) from speakers, or transducers, apparently relying on unnamed prior art (incorrectly describing the Poco reference, at line 6 of page 4 of the Action, as "the Poco reference, wherein it is common have automatic audio disconnection of an audio device when there is an telephone coupled within the same system of use.")

As noted in applicants' Remarks submitted with the Amendment of January 8, 2003, Poco does *not* teach, disclose or suggest disconnection of an audio *signal*, and it therefore again appears that the Examiner failed to consider applicants' amendment, referring only to disconnection of an audio *circuit* from a power source, while failing to consider the amendment of claim 8 which clarified that the second means operates "for automatically disconnecting the audio signal provided by said first plug from the electroacoustical transducer".

Therefore, it is again clear that the Action fails to respond to the amendment and that a corrected Action, providing a proper response to the Amendment, is in order.

3. The Examiner's "Response to Arguments" Moreover Fails to Identify Motivation for Combining the References as Suggested by the Examiner in Hindsight, and Requires Correction and Reconsideration

It is also noted that the last three lines of paragraph 5 on page 4 of the Action provide a statement that "Poco is provided only to teach the automatic function between two devices". If so, then the Examiner appears to admit that Poco does not teach any motivation for applying such automatic functioning to only one, very specific, portion of the Young reference.

Therefore, it is courteously submitted and without suggestion for specific application to the recited structural configuration recited in the claims, would not motivate one of ordinary skill to modify a very specific portion of the Young reference.

Nonetheless, the Examiner appears to conclude that the Poco Reference would have motivated one of ordinary skill to modify the Young disclosure by providing automatic disconnection of an *audio signal* from a transducer, in response to a detection signal, rather than by incorporating the Poco teaching of *disconnecting the audio circuit from power*.

Therefore, it is courteously submitted that the Action again fails to address the amended language and, moreover, relies on *hindsight reasoning* rather than on any prior art for motivation for modification of the primary Young reference.

Accordingly, reconsideration of the rejection is requested along with provision of a corrected Action.

4. The Syntax in the “Response to Arguments” Cannot be Understood and Requires Correction

Applicants courteously submit that the phrasing and syntax used in the “Response to Arguments” makes the Response difficult to interpret or to reply thereto, and thus requires correction. This assertion is illustrated by the following:

a). The statement that

“The reference discloses the power being interrupted, which may be interpreted as disconnecting and/or muting, from the audio device when there is an incoming phone call and is the significance of the teachings the Poco reference, wherein it is common have automatic audio disconnection of an audio device when there is an telephone coupled within the same system of use”

is incomprehensible because:

i) “and is the significance of the teachings the Poco reference” fails to identify *what* is the significant teaching - is it “the power being interrupted”? If so, the word “and” obfuscates the assertion; is it “disconnecting and/or muting”? If so, then the Action fails to identify any basis by which interruption of power may be interpreted not just as disconnecting, but also as “and/or muting”.

ii) As noted at (2) above, “the Poco reference, wherein it is common have automatic audio disconnection of an audio device” is erroneous if read as alleging that such automatic audio disconnection is common in the Poco reference; on the other hand, if read as stating that such disconnection is common in the prior art, the statement fails to identify where (i.e., in what

prior art) is it common to have automatic disconnection and fails to indicate whether the Examiner is taking official notice of such an assertion or is relying on the Examiner's own knowledge to make the statement.

In that regard, the Examiner is reminded that "Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge." MPEP §2144.03(B)

iii) "automatic audio disconnection of an audio device when there is an telephone coupled within the same system of use" is incomprehensible; did the Examiner mean "when there is an incoming telephone call [coupled] within the same system"? could the Examiner have meant "[an] a telephone coupled to the same system"?

It is courteously submitted that the uncertainties as to interpretation of the Examiner's Response makes it impossible to reply thereto and, accordingly, that a corrected Action is required to provide applicant an appropriate opportunity to reply.

It is therefore respectfully submitted that the outstanding Official Action is defective, in failing to address the claims as amended by the paper filed January 8, 2003, as well as in failing to provide a Response to which applicants can reasonably reply.

In view of the foregoing, it is courteously submitted that a Corrected Action is in order, which addresses the language of the pending claims, as amended, and

which properly addresses applicants' remarks in a manner to which applicants may reasonably and fully reply.

Still further, in view of failure of the Action to identify prior art motivation for modification of the primary reference, it is courteously submitted that the Action relies on hindsight reasoning obtained from reading applicants' own disclosure and claims as a basis for modifying the primary Young reference and thus fails to make a *prima facie* showing of obviousness under 35 USC 103.

It is accordingly submitted that each of claims 8 and 10 in the application is either in condition for allowance or has been improperly rejected.

In either case, a new Action is in order and is courteously requested.

Respectfully submitted,
Clark & Brody



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September 29, 2003